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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201				
EXAMINER WILLETT, STEPHAN F				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/454,221
Filing Date: December 09, 1999
Appellant(s): APPIAH ET AL.

Glen Kubota
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/15/05.

(1) *Real Party in Interest*

Examiner agrees with the statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Examiner agrees with the statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

Examiner agrees with the statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

Examiner agrees with the appellant's statement of the status of amendments contained in the brief is correct.

(5) *Summary of Claimed Subject Matter*

Examiner agrees with the summary of the *claimed subject matter* contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed*

Examiner agrees with the appellant's statement of the grounds of the rejection in the brief is correct.

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Grounds of Rejection*

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 15, 26, 33, and 35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the "installing ... not at the client" is not written in the Specification.

Claim Rejections - 35 USC § 103

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-40 are rejected under 35 U.S.C. 103(a) as being unpatentable by Poger et al. with Patent Number 6,772,420 over in view of Kathail et al. with Patent Number 5,802,365.

6. Regarding claim(s) 1, 14-17, 26-28, 33-35, Poger teaches determining driver compatibility. Poger teaches receiving at the server, col. 1, lines 35-38 a driver identifier for a network device/client attached to the client[network device], col. 3, line 65, by the client as "itself ... with a unique IP address" and "automatically", col. 4, lines 4-6. Poger teaches selecting a closest matching driver as "matching", col. 4, lines 64-65. Poger teaches installing the selected driver, col. 5, lines 28-31. Poger teaches interacting or using the installed driver, col. 5, lines 31-35. Poger teaches a driver library as DLL, col. 4, lines 66-67. Poger teaches installing a driver on the server side as "installs it on a network server", col. 5, lines 29-30 for application at the client device as "querying the particular device", col. 5, lines 31-35. Applications are running on both the server and client to at least enable them to communicate, however Poger describes a "suite of application programs", col. 1, lines 56 for other requirements. Also, Poger teaches server applications "interact" with the network client device, col. 5, lines 31-35. Poger teaches not installing at the client as not requiring additional software at the network device/client, col. 3, lines 1-3 and implicitly based on the negative limitation. Poger teaches the invention in the above claim(s) except for explicitly teaching installing a print driver. In that Poger operates to generate compatible drivers, the artisan would have looked to the software upgrade arts for details of implementing software compatibility. In that art, Kathail, a related driver installation system, teaches "automatically determining a driver and corresponding family for a particular device", col. 54, lines 55-56 in order to provide a driver for a device. Kathail specifically teaches a "printing device", col. 6, line 5 as one of the peripheral devices that may need a driver. Further,

Kathail suggests further drivers “for a particular device coupled with a computer system”, col. 4, line 56 will result from implementing his driver matching system. The motivation to incorporate matching print drivers insures that distributed processing in an open platform is supported, especially with thin-clients. Thus, it would have been obvious to one of ordinary skill in the art to incorporate a matching print driver taught in Kathail into the driver update system described in the Poger patent because Poger operates with drivers and Kathail suggests that optimization can be obtained with print drivers. Therefore, by the above rational, the above claim(s) are rejected.

7. Regarding claims 2, Poger teaches receiving a driver identifier from the client as “unique hardware address” of the client, col. 4, lines 48-55. Thus, the above claim limitations are obvious in view of the combination.

8. Regarding claim(s) 3, 9, 37, Poger teaches determining driver compatibility. Poger teaches receiving at the server, col. 1, lines 35-38 a driver identifier for a network device/client attached to the client[network device], col. 3, line 65, by the client as “itself ... with a unique IP address” and “automatically”, col. 4, lines 4-6. Poger teaches selecting a closest matching driver as “matching”, col. 4, lines 64-65. Poger teaches installing the selected driver, col. 5, lines 28-31. Poger teaches interacting or using the installed driver, col. 5, lines 31-35. Poger teaches a driver library as DLL, col. 4, lines 66-67. Poger teaches installing a driver on the server side as “installs it on a network server”, col. 5, lines 29-30 for application or interaction at the client device as “querying the particular device”, col. 5, lines 31-35. Applications are running on both the server and client to at least enable them to communicate, however Poger describes a “suite of application programs”, col. 1, lines 56 for other requirements. Also, Poger teaches server applications “interact” with the network client device, col. 5, lines 31-35. Poger

teaches not installing at the client as not requiring additional software at the network device/client, col. 3, lines 1-3 and implicitly based on the negative limitation. Poger teaches the invention in the above claim(s) except for explicitly teaching installing a closest matching type driver system, such as by name and version, on the server side for printing at the client printer. In that Poger operates to generate compatible drivers, the artisan would have looked to the software upgrade arts for details of implementing software compatibility. In that art, Kathail, a related driver installation system, teaches "automatically determining a driver and corresponding family for a particular device", col. 54, lines 55-56 in order to provide a driver for a device. Kathail specifically teaches "a name registry", col. 5, lines 29-30 based on driver name and version, col. 10, lines 65-66. Print driver selection is taught to print at a client. Further, Kathail suggests further functions such as "driver's compatible names", col. 23, line 36-37 will result from implementing his driver matching system. The motivation to incorporate matching of drivers types insures that distributed processing in an open platform is supported, especially with thin-clients. Thus, it would have been obvious to one of ordinary skill in the art to incorporate a matching print driver type system as taught in Kathail into the driver update system described in the Poger patent because Poger operates with drivers and Kathail suggests that optimization can be obtained with print drivers based on various matching techniques. Therefore, by the above rational, the above claim(s) are rejected.

9. Regarding claims 4, 29, 38, Kathail teaches a library, col. 6, lines 59-62. The motivation to incorporate matching of drivers types of systems insures that distributed processing in an open platform is supported, especially with thin-clients, as described above. Thus, the above claim limitations are obvious in view of the combination.

10. Regarding claims 5, 18, 21, 30, 39, Kathail teaches same driver matching, col. 22, lines 40-41. The motivation to incorporate matching of drivers types of systems insures that distributed processing in an open platform is supported, especially with thin-clients, as described above. Thus, the above claim limitations are obvious in view of the combination.

11. Regarding claims 6, 8, 19-20, 40, Kathail teaches different driver matching but one that corresponds with notification, col. 22, lines 59-60, 63-64. The motivation to incorporate matching of drivers types of systems insures that distributed processing in an open platform is supported, especially with thin-clients, as described above. Thus, the above claim limitations are obvious in view of the combination.

12. Regarding claims 7, Kathail teaches checking device driver name changes by category, col. 23, lines 53-60. The motivation to incorporate matching of drivers types of systems insures that distributed processing in an open platform is supported, especially with thin-clients, as described above. Thus, the above claim limitations are obvious in view of the combination.

13. Regarding claims 10-11, 22-23, 32, Kathail teaches driver matching but without regard to version, col. 23, lines 29-33 wherein first the driver names are matched, thus without regard to version, then "resolves prioritized ties by using version information" with relevant notification, col. 3, lines 41-42. The motivation to incorporate matching of drivers types of systems insures that distributed processing in an open platform is supported, especially with thin-clients, as described above. Thus, the above claim limitations are obvious in view of the combination.

14. Regarding claims 12-13, 24, Kathail teaches updating driver versions, col. 36, lines 10-14. The motivation to incorporate matching of drivers types of systems insures that distributed processing in an open platform is supported, especially with thin-clients,

as described above. Thus, the above claim limitations are obvious in view of the combination.

15. Regarding claims 31, Kathail teaches mapping drivers based on previous matches of devices as a device tree database and Name Registry, col. 6, lines 9, 23-25, 40-42 and installing new drivers, col. 6, lines 36-37 and 51-53 which inherently will have different names or identifiers. The motivation to incorporate matching of drivers types of systems insures that distributed processing in an open platform is supported, especially with thin-clients, as described above. Thus, the above claim limitations are obvious in view of the combination.

16. Regarding claims 36, Poger teaches server applications executing at the server such as for a thin client, col. 4, lines 56-58. Thus, the above claim limitations are obvious in view of the combination.

(10) Response to Argument

§112 Rejections

17. The 112 enablement rejection should have been a 112 written description rejection, as corrected above since there is no basis for an undue experimentation analysis, thus the enablement arguments are moot. The 102 rejection was written as a 103 rejection to clearly apply to a printer driver which the applicant did not dispute.

18. The Examiner would like to clarify and provide support in the record for his statements that the applicant made comment. The Applicant suggests "the Office

Art Unit: 2142

appears to be basing its enablement rejection at least in part on definitions of 'driver' and server/client", Paper Filed 8/15/05, Page 10, lines 17-18. Microsoft Press Computer Dictionary defines driver as "a device driver is a device-specific control program that enable a computer to work with a particular device, such as a printer".

Thus, in regard to applicant's statement "the Office does not provide any basis for the underlying [sic] statement", Paper Filed 8/15/05, Page 11, lines 10-11 above is the basis for the statement. Thus arguably, the computer or client as presently claimed, needs a "device-specific control program" to work with the attached printer, unless the client already had a driver installed or a client driver was not necessary. This issue was originally raised to provide clarity between the Office and the Applicant. Another issue that was not clearly addressed by the applicant here is the issue raised briefly in the 112 rejection in stating that "the Office provides no context for its assertion , e.g. are the roles reversed compared to the specification, or a reference?", Paper Filed 8/15/05, Page 11, lines 4-5. This issue is a little subtle, but basic to the client/server network paradigm. Microsoft Press Computer Dictionary defines server as "on a local area network (LAN), a computer running administrative software that controls access to the network and its resources, such as printers". The Office was simply trying to convey that claim 1 states "to print to the printer" "that is attached to the client" makes the client a server in claim 1. Based on the present claims, the roles of the client and server are reversed based on common industry usage. Again, this issue was originally raised to provide clarity between the Office and the Applicant.

§102 Rejections

Art Unit: 2142

19. Applicant's first substantive argument suggests that "Poger does not anticipate Claim 1 in light of the Office's own statement", Paper Filed 8/15/05, Page 14, lines 6-7, and the applicant applies the same rational to Kathail, Paper Filed 8/15/05, Page 19, lines 9-20. Clearly, the Office was stating that Poger does not explicitly refer to "name and version", which was the only portion of the cited claims that was not underlined. The Office was merely stating that Poger does not specify installing a driver specifically by "name and version". The "name and version " element does not appear in claim 1, it appears in claim 3. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

20. Applicant next suggests that "Poger is totally silent as to any applications executing on its communication server", Paper Filed 8/15/05, Page 14, lines 15-16. Inherently applications are running on both the server and client to at least enable them to communicate, however Poger describes a "suite of application programs", col. 1, lines 56 for other requirements. Applicant continues with "Poger does not teach every element of claim 1", Paper Filed 8/15/05, Page 14, lines 18-19 and "Poger does not describe applications executing on the server to print to a printer attached to a client as recited in Claim 1", 8/15/05, Page 14, lines 16-17. However, Poger clearly teaches server applications "interact" with the network client device, col. 5, lines 31-35 and Kathail specifically teaches their application to drivers for a "printing device", col. 6, line 5. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

21. Applicant next suggests that "the recited claim amendments neither imply other parts remaining nor are to avoid obvious elements of a reference", Paper Filed 8/15/05,

Art Unit: 2142

Page 15, lines 6-8. On 7/12/04 the applicant filed an amendment and the only element added to claim 1 was "and not at the client", while redacting other portions of the claim. Reiterated again "[The] specification, having described the whole, necessarily described the part remaining", In re Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977), see also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983) and "negative limitations extended to define the invention in terms of what it was not, rather than pointing out the invention", MPEP 2172.05(I). A negative type limitation, that implicitly teaches other related parts remaining, to avoid obvious elements of a reference does not exude novelty of the whole. There is no reason for this negative type element limitation that is not supported in the specification. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

Claims 26-28

22. Applicant next suggests that "Poger does not teach every element of claim 26", Paper Filed 8/15/05, Page 18, lines 15-16. The limitation in claims 26 states "corresponding driver" which reads on "closest matching driver" in claim 1. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

§103 Rejections

23. The same argument can be applied to Kathail is addressed above in the **§102 Rejections** section above.

24. Lastly, Applicant suggests "the Office provides an insufficient basis for combining Poger and Kathail", Paper Filed 8/15/05, Page 20, lines 6-7. The Poger and Kathail references are very related and Poger just applies the Kathail driver applications to

Art Unit: 2142

modern networks. Kathail suggests further functions such as "driver's compatible names", col. 23, line 36-37 will result from implementing his driver matching system. The motivation to incorporate matching of drivers types insures that distributed processing in an open platform is supported, especially with thin-clients. Thus, it would have been obvious to one of ordinary skill in the art to incorporate a matching print driver type system as taught in Kathail into the driver update system described in the Poger patent because Poger operates with drivers and Kathail suggests that optimization can be obtained with print drivers based on various matching techniques. Thus, Applicant's arguments can not be held as persuasive regarding patentability.

(11) *Related Proceedings Appendix*

Examiner agrees with the statement identifying the *related proceedings* contained in the brief is correct.

Thus, the prior art, as applied, fully suggest and teaches the limitations disclosed and claimed by the Appellant and Appellant's arguments cannot be held persuasive regarding patentability with regard to these limitations.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

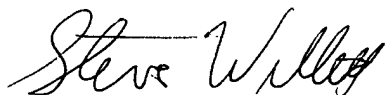
(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Art Unit: 2142

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:



Stephan Willett, Patent Examiner

Art Unit 2142

11/14/2005

Conferees:

Andrew Caldwell



Robert Harrell



**ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER**